

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
RICHMOND DIVISION

THE TRUSTEES OF COLUMBIA
UNIVERSITY IN THE CITY OF NEW
YORK,

Plaintiff

vs.

SYMANTEC CORPORATION,

Defendant

Civil Action No. 3:13-cv-00808-JRS

JURY TRIAL DEMANDED

**SYMANTEC CORPORATION'S RESPONSE TO
MOTION FOR LEAVE TO SUPPLEMENTAL AUTHORITY**

Defendant Symantec Corporation ("Symantec") states as follows in response to the Motion for Leave to Supplemental Authority filed by Plaintiff The Trustees of Columbia University in the City of New York ("Columbia") (Dkt. 224).

Columbia seeks the Court's leave to submit a decision by the Patent Trial and Appeal Board ("PTAB") in *Kingston Technology Co. v. Spex Technologies Inc.*, IPR No. 2018-01002, Paper No. 12 (P.T.A.B. Nov. 6, 2018) in support of Columbia's Motion for Summary Judgement. Dkt. 224 at 1.

Symantec does not oppose Columbia's motion. However, the *Kingston Technology* decision is not binding on this Court, and the PTAB cannot reverse the Federal Circuit's decision in *Shaw Industries Group, Inc. v. Automated Creel Systems, Inc.*, 817 F.3d 1293, 1300 (Fed. Cir. 2016). See *Tinnus Enterprises, LLC v. Telebrands Corp.*, 846 F.3d 1190, 1202 (Fed. Cir. 2017) (stating that a PTAB decision is not binding on the Federal Circuit). Symantec therefore urges

the Court to credit the plain language of the *Shaw* decision over the non-binding decision of the PTAB.

In addition, the Federal Circuit has favorably cited *Shaw Industries* regarding IPR estoppel subsequent to *SAS*. See *Google LLC v. Conversant Wireless Licensing S.A.R.L.*, --- Fed.Appx. ----, 2018 WL 6072337, *4 (Fed. Cir. Nov. 20, 2018). Namely, the Federal Circuit cited *Shaw Industries* to support the proposition that “both LGE and Google would potentially be collaterally estopped under 35 U.S.C. § 315(e) from making certain anticipation and obviousness arguments.” The PTAB’s suggestion in *Kingston* that *Shaw Industries* is limited to “pre-*SAS*” circumstances is therefore contrary to the Federal Circuit’s continuing reliance on *Shaw Industries* regarding estoppel.

SYMANTEC CORPORATION

By: /s/ David A. Nelson

Dabney J. Carr, IV, VSB #28679
TROUTMAN SANDERS LLP
P. O. Box 1122
Richmond, Virginia 23218-1122
Telephone: (804) 697-1200
Facsimile: (804) 697-1339
dabney.carr@troutmansanders.com

David A. Nelson (*pro hac vice*)
davenelson@quinnemanuel.com
Stephen A. Swedlow (*pro hac vice*)
stephenswedlow@quinnemanuel.com
500 West Madison St., Suite 2450
Chicago, Illinois 60661
Telephone: (312) 705-7400
Facsimile: (312) 705-7401
QUINN EMANUEL URQUHART & SULLIVAN
LLP

Yury Kapgan (*pro hac vice*)
yurykapgan@quinnemanuel.com
865 S. Figueroa St., 10th Floor
Los Angeles, California 90017
Telephone: (213) 443-3000
Facsimile: (213) 443-3100
QUINN EMANUEL URQUHART &
SULLIVAN LLP

Derek L. Shaffer (*pro hac vice*)
derekshaffer@quinnemanuel.com
777 6th Street NW, 11th floor
Washington, D.C. 20001-3706
Telephone: (202) 538-8000
Facsimile: (202) 538-8100
QUINN EMANUEL URQUHART &
SULLIVAN LLP

ATTORNEYS FOR DEFENDANT SYMANTEC
CORPORATION

CERTIFICATE OF SERVICE

I hereby certify that on November 23, 2018, I electronically filed the foregoing pleading with the Clerk of Court using the CM/ECF system, which then will send automatic notification of such filing (NEF) to the following:

Dana D. McDaniel (VSB No. 25419)
dmcdaniel@spottsfain.com
John M. Erbach (VSB No. 76695)
jerbach@spottsfain.com
Spotts Fain, P.C.
411 East Franklin Street, Suite 600
Richmond, Virginia 23219
Phone: (804) 697-2065
Fax: (804) 697-2165

Garrard R. Beeney (*pro hac vice*)
beeneyg@sullcrom.com
Stephen J. Elliott (*pro hac vice*)
elliotts@sullcrom.com
W. Rudolph Kleysteuber (*pro hac vice*)
kleysteuberr@sullcrom.com
Dustin F. Guzior (*pro hac vice*)
guziord@sullcrom.com
SULLIVAN & CROMWELL LLP
125 Broad Street
New York, New York 10004
Phone: (212) 558-4000
Fax: (212) 558-3588

***Counsel for The Trustees of Columbia University
In the City of New York***

/s/ _____
Dabney J. Carr, IV, VSB #28679
TROUTMAN SANDERS LLP
P. O. Box 1122
Richmond, Virginia 23218-1122
Telephone: (804) 697-1200
Facsimile: (804) 697-1339
dabney.carr@troutmansanders.com
Counsel for Defendant Symantec Corporation